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09/863,997	05/23/2001	Lyle W. Shaw	F-167	1864

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PITNEY BOWES INC.  
35 WATERVIEW DRIVE  
P.O. BOX 3000  
MSC 26-22  
SHELTON, CT 06484-8000

EXAMINER

PARK, CHAN S

ART UNIT

PAPER NUMBER

2622

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/863,997	Applicant(s) SHAW ET AL.	
	Examiner CHAN S. PARK	Art Unit 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 6-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 6-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)          |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. <u>20050608</u> .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____.  | 6) <input type="checkbox"/> Other: _____.                                   |

## DETAILED ACTION

### *Response to Amendment*

1. Applicant's amendment filed on 2/23/05 and corrected amendment filed on 6/8/05, have been entered and made of record. Currently, **claims 1-3 and 6-9** are pending.

### *Response to Arguments*

2. Upon review of the reference of Yoshikawa (U.S. Patent No. 6,624,902), which was cited in the Office Action dated 11/19/04 under 35 U.S.C. 102(e), as being anticipating **claims 1 and 3**, the examiner notes that the reference can still be interpreted as anticipating the claims, as currently amended.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., printing of the first markings having a first orientation along with the second markings having a second orientation on a single mailpiece) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The applicant states that after the first set of markings is printed onto a mailpiece having a first orientation, the same mailpiece is fed again in to the printer in an inverted orientation to print the second set of markings onto the mailpiece having the inverted orientation. The examiner agrees with the applicant, in that the process performed by the current invention is different than what

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Yoshikawa teaches. However, this difference is not apparent in the current claim wording. For example, it is uncertain as to whether the first set of markings must be always printed/present first in the mailpiece when the second set of markings is ready to be printed by the inverted print module. The claim, as it is written, appears to indicate that as long as the mailpiece is fed into the printer in an inverted orientation, the second set of markings is printed in the inverted orientation. It is respectfully noted, based on the current claim wording, that the printing of the second set of markings is independent of the presence of the first set of markings on the mailpiece. It is only dependent on the orientation of the mailpiece according to the current claim wording.

Therefore, the rejection of **claims 1 and 3**, as cited in the Office Action dated 11/19/04, under 35 U.S.C. § 102(e), as being anticipated by Yoshikawa, is maintained and repeated in this Office Action.

Applicant's arguments filed 6/8/05 have been fully considered but they are not persuasive.

3. With respect to the applicant's argument regarding **claims 6 and 9**, arguments analogous to those presented for claims 1 and 3, are applicable.

Therefore, the rejection of **claims 6 and 9**, as cited in the Office Action dated 11/19/04, under 35 U.S.C. § 102(e), as being anticipated by Yoshikawa, is maintained and repeated in this Office Action.

### ***Claim Objections***

4. Claim 1 is objected to because of the following informalities:

Line 4, "first and second set of markings" should be -- first and second sets of markings --;

Line 18, "representative of first or second" should be -- representative of the first or second sets of --;

Appropriate correction is required.

The following quotations of 37 CFR 1.75(a) is the basis of objection:

(a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.

5. Claim 1 is objected to under 37 CFR 1.75(a) as failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention or discovery. It is unclear whether the "one of more markings" in line 5, are different from "the first set of markings from the memory" and "the second set of markings from the memory" (lines 7 and 11, respectively).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 3 recites the limitation "the markings". There is insufficient antecedent basis for this limitation in the claim. It is unclear as to whether the markings are referring to the first set of markings or the second set of markings or both.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3, 6 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Yoshikawa.

7. With respect to claim 1, Yoshikawa discloses a system for printing markings (fig. 4) along a top and bottom of a mailpiece comprising:

a print head in a fixed position (print engine 407), where the print head receives print instructions and prints first and second sets of markings onto the mailpiece (col. 6, lines 22-26 and S903 in fig. 9);

a memory (graphics memory 405) containing data representative of one or more markings (col. 6, lines 20-24);

a print module, coupled to the memory and to the print head, for reading the data representative of the first set of markings from the memory, and converting the data to print instructions that instruct the print head to print the first set of markings onto the mailpiece having a first orientation (S508 in fig. 5);

an inverted print module, coupled to the memory and to the print head, for reading the data representative of the second set of markings from the memory, and converting the data to print instructions that instruct the print head to invert the second set of markings on the print head during printing onto the mailpiece disposed in a second orientation which is inverted about 180 degrees with respect to the first orientation of the mailpiece (S509 in fig. 5); and

a control module, coupled to the print module and the inverted print module, for sending marking requests to either the print module or the inverted print module, the marking requests indicating which data representative of the first or second sets of markings that are to be read from the memory, by the print module or the inverted print module (S507 in fig. 5).

Also read col. 2, lines 25-45 and col. 11, lines 19-30.

Since the system prints the markings on an envelope (col. 11, line 10), it is apparent to one of ordinary skill in the art that an address of a recipient and an address of a sender are printed. Note that the Office interprets these addresses as the first and the second set of markings. Additionally, it is apparent that the addresses are printed

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along tops and bottoms of the envelope (the sender address on the top and the recipient address on the bottom). Further, note that a plurality of graphic markings and text markings can be printed on the mailpiece according to fig. 9.

8. With respect to claim 3, Yoshikawa discloses the system of claim 1, wherein the markings are characters, numbers, symbols, graphics, meter indicia, barcodes, POSTNET barcodes, advertisements, and/or advertisement slogans (col. 11, lines 10 & 19-24). The printed addresses include characters and numbers.

9. With respect to claim 6, Yoshikawa teaches a method of printing along tops and bottoms of mailpieces comprising:

printing, with a fixed print head, one or more first markings on a side of a mailpiece, the mailpiece in a first orientation (S508 in fig. 5);

receiving the mailpiece in a second orientation which is about 180 degrees from the first orientation (fig. 2B); and

printing on the side of the mailpiece, with the fixed print head, one or more second markings that are rotated on the print head about 180 degrees from the first orientation of the mailpiece (col. 2, lines 25-45; col. 11, lines 28-30 & S509 in fig. 5).

Since the system prints the markings on an envelope (col. 11, line 10), it is apparent to one of ordinary skill in the art that an address of a recipient and an address of a sender are printed. Note that the Office interprets these addresses as the one or more of markings from the memory. Additionally, it is apparent that the addresses are printed along tops and bottoms of the envelope (the sender address on the top and the



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recipient address on the bottom). Further, note that a plurality of graphic markings and text markings can be printed on the mailpiece according to fig. 9.

10. With respect to claim 9, Yoshikawa teaches the method of claim 6, wherein the one or more markings are characters, numbers, symbols, graphics, meter indicia, barcodes, POSTNET barcodes, advertisements, and/or advertisement slogans (col. 11, lines 10 & 19-24). The printed addresses include characters and numbers.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshikawa as applied to claim 1 above, and further in view of Oshima et al. U.S. Patent No. 5,932,139 (hereinafter Oshima).

11. With respect to claim 2, Yoshikawa discloses the system of claim 1, but it does not disclose expressly a scanner for capturing image data from the mailpiece and an optical character recognition, coupled to the scanner and to the control module, for converting the image data to computer data, where the control module queries a second memory for instructions as to what first set markings and/or second set of markings are related to the image data.

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Oshima, the same field of endeavor of the mailpiece printing, discloses a system comprising:

a scanner for capturing image data from the mailpiece; and

an optical character recognition, coupled to the scanner and to a control module, for converting the image data to computer data, where the control module queries a memory for instructions as to what barcode information (marking) are related to the image data (col. 51, line 65 – col. 52, line 4).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the OCR of Oshima into the envelope printing system of Yoshikawa.

The suggestion/motivation for doing so would have been to provide a printer that can print the barcode information in inverted orientation based on the address recognized by the OCR.

Therefore, it would have been obvious to combine Yoshikawa with Oshima to obtain the invention as specified in claim 2.

Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshikawa as applied to claim 6 above, and further in view of Oshima.

12. With respect to claim 7, Yoshikawa teaches the method of claim 6, but it does not teach expressly a method of determining address information from the mailpiece and a method of determining the one or more first markings based upon the address information.

Oshima, the same field of endeavor of the mailpiece printing, teaches the method of determining address information (zip) from a mailpiece and determining one or more first markings (barcode information) based upon the address information (col. 51, line 65 – col. 52, line 4).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the OCR of Oshima into the envelope printing system of Yoshikawa.

The suggestion/motivation for doing so would have been to provide a printer that can print the barcode information in inverted orientation based on the address recognized by the OCR.

Therefore, it would have been obvious to combine Yoshikawa with Oshima to obtain the invention as specified in claim 7.

13. With respect to claim 8, Yoshikawa teaches the method of claim 6, but it does not teach expressly a method of determining address information from the mailpiece and a method of determining the one or more second markings based upon the address information.

Oshima, the same field of endeavor of the mailpiece printing, teaches the method of determining address information (zip) from a mailpiece and determining one or more second markings (barcode information) based upon the address information (col. 51, line 65 – col. 52, line 4).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the OCR of Oshima into the envelope printing system of Yoshikawa.

The suggestion/motivation for doing so would have been to provide a printer that can print the barcode information in inverted orientation based on the address recognized by the OCR.

Therefore, it would have been obvious to combine Yoshikawa with Oshima to obtain the invention as specified in claim 8.

### ***Conclusion***

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **CHAN S. PARK** whose telephone number is (571) 272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

csp  
June 9, 2005

Chan S. Park  
Examiner  
Art Unit 2622



EDWARD COLES  
SUPERVISOR, PATENT EXAMINER  
TECHNOLOGY CENTER 2600